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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,119

05/11/2006

Rainer Gendermann

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GREER, BURNS & CRAIN  
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25TH FLOOR  
CHICAGO, IL 60606

EXAMINER

HSIAO, JAMES K

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

07/21/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,119	<b>Applicant(s)</b> GENDERMANN, RAINER	
	<b>Examiner</b> JAMES K. HSIAO	<b>Art Unit</b> 3657	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-33 is/are pending in the application.
- 4a) Of the above claim(s) 18, 19, 21, 24, 29-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16, 17, 20, 22, 23, 25-28, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 16, 17, 20, 22, 23, 25-28, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi (US 20020129926) in view of Rotter (US5351664).

Regarding claims 16, 32, and 33, Yamaguchi discloses a carrier element (46/47) that can be attached to an engine block of the internal combustion engine via a flange and carries at least one oil cooler (fig 4); the oil module being provided with at least one channel for guiding oil (39a/b) and at least one channel for guiding water (40a/b), one of the channels being an oil cooler bypass channel (23) connecting an oil inlet of the oil cooler to an oil outlet of the oil cooler (fig 1), an oil cooler base plate (25) forming one part of the oil cooler and occluding the oil cooler on the carrier side (paragraph 22), wherein at least a main part of the oil cooler bypass channel extends through the oil cooler base plate (fig 1, 25a) and is sealed towards at least one of an outside environment on the oil cooler side (fig 1, paragraph 22) by the remaining oil cooler and on the carrier element side by the carrier element (fig 1).

Yamaguchi lacks wherein an oil filter is attached to the carrier. Rotter teaches a oil cooling device wherein an oil filter is attached to a carrier of the cooling device (figs 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the carrier of Yamaguchi with the carrier of Rotter because attaching the necessary components of a oil cooling system using few components provide for an easily fitted or retrofitted assembly, saving space and attachment components (Rotter abstract).

Regarding claim 17, Yamaguchi discloses wherein the bypass channel is formed in the oil cooler base plate by at least one slit (25a) extending over an entire thickness of the oil cooler base plate (figs 1-2).

Regarding claim 20, as broadly recited , Yamaguchi discloses wherein one part of the oil cooler bypass channel (25a) lying in the oil cooler base plate forms a middle section of the oil cooler bypass channel and two shorter end sections of the oil cooler bypass channel each extend through the carrier element. The channel (25a) can be broken up and interpreted as any number of sections of several different dimensions.

Regarding claims 22 and 23, as broadly recited, Yamaguchi discloses sections of (25a and 23) the bypass channel which has cross-sections that are narrower in some sections than others (fig 1).

Regarding claim 25, Yamaguchi discloses wherein the cross-sectional narrowing is formed by at least one overlapping area (near 43, near reference numeral 25a)

Art Unit: 3657

between one end of the oil cooler bypass channel and a channel area on the carrier element side being connected with one of the oil inlet and oil outlet of the oil cooler (fig 1).

Regarding claims 26 and 28, Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. In this case, the structure is the base plate and the process by which it was created is the stamping.

Regarding claim 27, Yamaguchi discloses the use of aluminum as a material for the base plate (paragraph 26).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 16, 17, 20, 22, 23, 25-28, 32, and 33 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 3657

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES K. HSIAO whose telephone number is (571)272-6259. The examiner can normally be reached on Monday through Friday 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bradley T King/  
Primary Examiner, Art Unit 3657

Application/Control Number: 10/573,119

Page 6

Art Unit: 3657

JKH